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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/863,047	05/23/1997	FUMIAKI ITO	35.C12088	4264
5514	7590	12/13/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3694	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/863,047	ITO ET AL
	Examiner Ella Colbert	Art Unit 3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 September 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3,4,9,10,12,13,15-46,63,65 and 67-70 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1, 3, 4, 9, 10, 12, 13, 15-46, 63, 65, and 67-70 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Claims 1, 3, 4, 9, 10, 12, 13, 15-46, 63, 65, and 67-70 are pending in this communication filed 09/29/06 entered as Response After Non-Final Action (Miscellaneous Communication to Applicants').
2. The ExParte Quayle Action of 04/03/06 and allowance is hereby withdrawn in view of some remaining issues that have been raised after a thorough review of the claims as set forth here below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "a folder searcher for searching the plurality of folders ..., ..., ...;". It is unclear from the claim language, the Specification, and drawings whether the "folder searcher" is an application or a device or a person that performs the search. Claims 9 and 12 have a similar problem.

It is also unclear and vague in the claim language of claims 4-10 and 13 as to what "similarity degree" and "calculating a similarity order" mean. It is respectfully requested that Applicants' clarify these limitations in the claim language.

Claim 9 has a problem in the preamble and body of the method claim. The preamble recites "a document processing method of a document processing system includes a processing unit and memory, the method comprising the steps of:". The

preamble crosses to separate statutory classes of invention by mixing method and system elements in the preamble.

Claims 1, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Claim 1, after step 1, it is suggested as follows: "new document folder retainer means for retaining a new document folder; a folder search for searching the plurality of folders to identify at least one candidate folder from the plurality of folders suitable for storing the new document by comparing a feature of the new document with an average of features of the documents stored in at least one candidate folder among the plurality of folders, wherein the at least one candidate folder has documents more similar to the new document than other documents in the plurality of folders; ...".

Claims 9 and 12 have a similar problem.

Claims 3, 4, 10, 13, 15-46, 63, 65, and 67-70 are also rejected because of their dependency on a rejected base claim.

#### **Requirement for Information Under 37 C.F.R. 1.105**

5. Applicants' and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

*The information is required to identify what source(s) the formulas on pages 8-13, 18, 22, and 27-30 were obtained from. The Examiner reminds Applicants that they must disclose documents and publications known to them that are relevant to the*

Art Unit: 3694

*subject matter of this application. In particular, copies of any of the sources from which the formulas were taken from if they are not the inventors own formulas..*

The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in Applicant's disclosure.

The Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the Applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

7. **Conclusion:** If the formulas in the disclosure are the Applicants' own formulas, it is suggested that the formulas at page 13, lines 11-12 and at page 27, lines 6-7 and lines 26 and 27 be incorporated into the independent claims exactly as written in the Applicants' disclosure.

#### Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 08/863,047  
Art Unit: 3694

Page 6

December 11, 2006



ELLA COLBERT  
PRIMARY EXAMINER